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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/318,031 05/25/99 MARKO

F XM-0022

EXAMINER

WM02/0104

BENMAN & COLLINS
2049 CENTURY PARK EAST
SUITE 2740
LOS ANGELES CA 90067

DAVIS, T

ART UNIT

PAPER NUMBER

2681

DATE MAILED:

01/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/318,031

Applicant(s)

Marko et al.

Examiner

Temica M. Davis

Group Art Unit

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☒ Responsive to communication(s) filed on May 25, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-25 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: On page 8, lines 24-26 of the specification, the applicant has incorporated a U.S Patent Application by reference. However, the applicant must provide the application number and the filing date of that application.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-3 and 6-10 rejected under 35 U.S.C. 102(e) as being anticipated by Wang, U.S. Patent No. 5,940,750.

Regarding claim 1, Wang discloses an interoperable receiver comprising first means for receiving signals in a first band second means for downconverting said received signals in the

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first band, third means for receiving signals in a second band fourth means for downconverting signals in the second band and fifth means for selectively outputting signals from the first band of the second band (col. 7, lines 25-65).

Regarding claim 2, Wang discloses the invention of Claim 1 wherein said first band includes multiple carriers (col. 7, lines 43-46).

Regarding claim 3, Wang discloses the invention of Claim 1 wherein said second band includes multiple carriers (col. 7, lines 43-46).

Regarding claim 6, Wang discloses the invention of Claim 1 wherein the first and the third means is a radio frequency antenna (col. 4, lines 35-37).

Regarding claim 7, Wang discloses the invention of Claim 6 wherein the output of the antenna is input to a filter (col. 4, lines 18-26).

Regarding claim 8, Wang discloses the invention of Claim 7 wherein the filter is an image filter (col. 4, lines 18-26).

Regarding claim 9, Wang discloses the invention of Claim 7 wherein the filter is a selectivity filter (col. 4, lines 18-26).

Regarding claim 10, Wang discloses the invention of Claim 6 wherein the second means and the fourth means is a mixer (col. 7, lines 7-16).

4. Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Campanella et al (Campanella), U.S. Patent No. 6,115,366.

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Regarding claim 25, Campanella discloses a satellite radio receiver architecture comprising: first means for receiving an audio datastream; second means for receiving a data datastream; and third means for selectively outputting said audio and said data bitstreams (abstract and col. 1, lines 27-36).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 5 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, U.S. Patent No. 5,940,750 and well known prior art.

Regarding claims 4 and 5, Wang discloses the invention of Claim 1 as described above.

Wang, however, fails to disclose wherein the first kind is the X M band (claim 4) and the second kind of band is a CD band (claim 5).

The examiner, contends, however, that these kinds of bands are well known in the art, and that it would have been obvious to one of ordinary skill in the art to modify Wang with these

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types of bands since it was very well known in the art that these types of bands are used in the communications field.

Regarding claim 20, Wang discloses an interoperable receiver comprising: first means for receiving signals in a first band; second means for downconverting said received signals in the first band; third means for receiving signals in a second band; fourth means for downconverting signals in the second band; and control means for selectively outputting signals from the first or second bands.

Wang, however, fails to specifically disclose wherein the firstband is an XM band, and the second band is a CD band.

The examiner, contends, however, that these kinds of bands are well known in the art, and that it would have been obvious to one of ordinary skill in the art to modify Wang with these types of bands since it was very well known in the art that these types of bands are used in the communications field.

Regarding claim 21, the combination of Wang and well known prior art discloses the invention of Claim 20 further including means for simultaneously receiving first and second ensembles, said first ensemble including a first signal from a first source, a first signal from a second source and a first signal from a third source and said second ensemble including a second signal from said first source, a second signal from said second source and a second signal from said third source (Wang, col. 7, lines 25-35).

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Regarding claim 22, the combination of Wang and well known prior art discloses the invention of Claim 21 further including means for selectively outputting signals transmitted within said first and said second ensembles (col. 7, lines 25-35).

7. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, U.S. Patent No. 5,940,750 and Anderson et al (Anderson), U.S. Patent No. 5,940,750.

Regarding claim 11, Wang discloses the invention of Claim 10, and further discloses a self oscillating mixer.

Wang, however, fails to disclose wherein the mixer is driven by a voltage controlled oscillator.

Anderson discloses a mixer driven by a voltage controlled oscillator (abstract and col. 9, lines 35-52).

At the time of invention, it would have been obvious to a person having ordinary skill in the art to modify Wang with the teachings of Anderson, since as evidenced by Anderson, this type of oscillation is very well known in the art.

Regarding claim 12, the combination of Wang and Anderson discloses the invention of Claim 11 wherein the voltage controlled oscillator is driven by a synthesizer (e.g. via item 130) (Anderson, col. 9, lines 39-44).

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Regarding claim 13, the combination of Wang and Anderson discloses the invention of Claim 12 wherein the fifth means inherently includes a controller as evidenced by the fact that the switch is capable of controlling which band is selected (Wang, col. 7, lines 44-65).

8. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, U.S. Patent No. 5,940,750, Anderson et al (Anderson), U.S. Patent No. 5,940,750 and well known prior art.

Regarding claim 14, the combination of Wang and Anderson discloses the invention of Claim 13 wherein the synthesizer is controlled by the controller to cause said receiver to selectively output signals received in the first or second band (Wang, col. 7, lines 43-65 and Anderson, abstract).

The combination, however, fails to specifically disclose wherein the first and second bands are XM and CD, respectively.

The examiner, contends, however, that these kinds of bands are well known in the art, and that it would have been obvious to one of ordinary skill in the art to modify the combination of Wang and Anderson with these types of bands since it was very well known in the art that these types of bands are used in the communications field.

Regarding claim 15, the combination of Wang and Anderson discloses the invention of Claim 13 further as described above.

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The combination, however, fails to specifically disclose means for digitizing the output of the mixer.

The examiner, however, contends that the process of digitizing is very well known in the art and that at the time of invention, it would have been obvious to a person of ordinary skill in the art to digitize the signal from the mixer to provide a more clear signal.

Regarding claim 16, the combination of Wang, Anderson and well known prior art discloses the invention of Claim 15 further including means for simultaneously receiving first and second ensembles, said first ensemble including a first signal from a first source, a first signal from a second source and a first signal from a third source and said second ensemble including a second signal from said first source, a second signal from said second source and a second signal from said third source (Wang, col. 7, lines 25-35).

Regarding claim 17, the combination of Wang, Anderson and well known prior art discloses the invention of Claim 16 further including means for selectively outputting signals transmitted within said first and said second ensembles (Wang, col. 7, lines 25-65).

9. Claims 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, U.S. Patent No. 5,940,750, Anderson et al (Anderson), U.S. Patent No. 5,940,750 and Campanella et al (Campanella), U.S. Patent No. 6,115,366.

Regarding claim 18, the combination of Wang and Anderson discloses the invention of Claim 15.

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The combination, however, fails to specifically disclose means for outputting an audio signal along with a data signal.

Campanella discloses means for outputting an audio signal along with a data signal (col. 1, lines 26-48).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Wang and Anderson with the teachings of Campanella for the purpose of having the capability to hear and see programming.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, U.S. Patent No. 5,940,750 and Campanella et al (Campanella), U.S. Patent No. 6,115,366.

Regarding claim 19, Wang discloses the invention of Claim 1.

Wang, however, fails to disclose means for outputting an audio signal along with a data signal.

Campanella discloses means for outputting an audio signal along with a data signal (col. 1, lines 26-48).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Wang with the teachings of Campanella for the purpose of having the capability to hear and see programming.

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11. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, U.S. Patent No. 5,940,750, well known prior art and Campanella et al (Campanella), U.S. Patent No. 6,115,366.

Regarding claims 23 and 24, the combination of Wang and well known prior art discloses the invention of Claims 22 and 20 as described above.

The combination, however, fails to disclose means for outputting an audio signal along with a data signal.

Campanella discloses means for outputting an audio signal along with a data signal (col. 1, lines 26-48).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Wang and well known prior art with the teachings of Campanella for the purpose of having the capability to hear and see programming.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306 or (703) 308-6296 (for any communications intended for entry).


Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



Temica M. Davis

January 2, 2001


NAY MAUNG
PRIMARY EXAMINER